

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No. : 09/770185  
Applicant : Lawrence  
Filing date : January 29, 2001  
Title : Mail Opener Apparatus  
TC/A.U. : 3724  
Examiner : Flores Sanchez  
Docket No. : 4969  
Customer No. : 26936

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*Charles W. Fallow*

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Commissioner for Patents  
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**TRANSMITTAL OF APPELLANT'S BRIEF ON APPEAL**  
**AND PETITION FOR EXTENSION OF TIME**

Appellant's Brief on Appeal to the BPAI is attached.

Please extend the period for filing Applicant's Brief on Appeal by four months,  
to today, November 3, 2006. The brief accompanies this request.

Kindly charge the fees required under 37 CFR 41.20(b)(2) and 37 CFR 1.17(d),  
and any deficiency, to Deposit Account 19-2110.

*Charles W. Fallow*

Charles W. Fallow  
Reg. No. 28946

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**APPELLANTS' BRIEF ON APPEAL TO**  
**THE BOARD OF PATENT APPEALS AND INTERFERENCES**

This is appellant's brief on appeal to the Board of Patent Appeals and Interferences, from the final rejection of the application identified above.

**REAL PARTY IN INTEREST**

The owner of this application is Neopost Limited, under an assignment recorded at reel 011491 frame 0236.

**RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences.

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### STATUS OF CLAIMS

Claims 1 - 17 have been canceled. Claims 18 - 27 stand rejected.

### STATUS OF AMENDMENTS

No amendments were filed subsequent to the close of prosecution. All amendments have been entered.

### SUMMARY OF CLAIMED SUBJECT MATTER

The invention claimed in claim 18 is a mail opener for use with a postage meter. The mail opener includes a print head (item 12, Fig. 2; page 5, line 24 of specification) movable between an operative, printing position and an inoperative position (see arrows A, Fig. 1, page 5, lines 28 et seq. of specification), a cutting device (blade 2, Fig. 2, page 5, line 2 of specification) movable (see arrows C, Fig. 1, page 5, line 3 of specification) between an operative position to open mail pieces and a retracted, inoperative position in which the cutting device is maintained out of engagement with mail pieces and drive means operable to displace the cutting device between the operative and inoperative positions. The drive means (which includes the cam slider 6 having a slot 8 and an end portion 9, strip having angled cam portion 7, and the guides 11, each having an angled slot 10 and fixed to the print head carrier 12, all shown in Fig. 1 and described at page 5, lines 15 - 26) is operated by movement of the print head into the printing position to move the cutting device into the inoperative position.

Claim 22 requires the cutting device to be a rotatably-driven rotary blade. The blade is element 2 in Fig. 2, and is described at page 5, line 2 of the specification.

Claim 23 adds to claim 18 a driven feed means operative to draw mail pieces past the

cutting device. The feed means includes the feed roller 4b and pressure roller 4a shown for example in Fig. 2 and described at page 5, line 4.

Claim 24 recites that the driven feed means of claim 23 comprises a driven feed roller and a pressure roller co-operating therewith.

Claim 25 adds to claim 23 the additional element of means for adjusting the speed of the driven feed means. This element is identified by reference 5d in Figure 1, and in the first paragraph of the Description of the Preferred Embodiment, as amended. Support is found in original claim 9.

#### ISSUES TO BE REVIEWED ON APPEAL

The issues on appeal are (a) whether the drawings adequately show the claimed invention, (b) whether claims 18 - 21 and 26 - 27 are anticipated by Woodie *et al.* (U.S. Patent 3757685), (c) whether claim 22 is obvious over Woodie *et al.* in view of Oussani (U.S. Patent 4419915), and (d) whether claims 23 - 25 are obvious over Woodie *et al.* in view of Clark (U.S. Patent 4493252).

#### ARGUMENT

##### Drawing Rejection - 37 CFR 1.83(a)

The Examiner held that the speed adjustment means is not shown in the drawings. That is not so; Figure 1 references the speed adjustment means with reference sign 5d. Corresponding description is in the first paragraph of the Description of the Preferred Embodiment section as amended August 8, 2005.

Claim Rejections - 35 USC 102

The Examiner maintains that the subject-matter of claims 18 to 21, 26 and 27 is anticipated by the disclosure of Woodie *et al.* (US-3757685). The rejection of claim 18 is: "Woodie *et al.* discloses (Fig. 1 - 26) the invention including a print head (122 and 124), a cutting device 148 and drive means 140."

We submit that claim 18 in particular is not anticipated by Woodie *et al.*, because the claim contains limitations not found in the reference. Anticipation under 35 U.S.C. 102(e) requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

Claim 18 recites "A mail opener for use with a postage meter..." Elements recited in preamble[s] are treated as limitations when they are necessary to give meaning to the claim[s] and properly define the invention. *Perkin Elmer Corp. v. Computervision*, 221 USPQ 669, 675 (Fed. Cir. 1984), cited as authority in *In re Fritch*, 23 USPQ2d 1780, 1781 (Fed. Cir. 1992). The preamble of claim 18 was intended as a limitation, and is clearly essential to a proper understanding of what the invention is in this application.

Woodie *et al.* does not disclose a mail opener for use with a postage meter. Rather, it discloses a ticket issuing machine.

It may be the Examiner's position that the machine of Woodie *et al.* is capable of opening mail, and, as such, provides a mail opener as required by claim 18. This is manifestly not the case. The machine of Woodie *et al.* has no means whatsoever by which a mail item, which is a discrete element, can be introduced to allow for opening of the mail item. As mail items cannot be introduced into the machine of Woodie *et*

*al.*, the machine is incapable of operating as a mail opener.

Moreover, the machine of Woodie *et al.* is not operative to open mail items in the manner of the claimed invention, but rather is a ticket issuing machine, which includes a knife (148) for cutting printed ticket stock. Ticket stock cannot be opened.

Claim 18 further requires (a) a print head which is movable between operative and inoperative positions, (b) a cutting device which is movable between operative and inoperative positions, and (c) drive means which is operative to displace the cutting device to the inoperative position in response to movement of the print head to the operative position.

In the machine of Woodie *et al.*, the print head (122) is fixed.

By grouping elements 122 and 124 together in the rejection, the Examiner implied that Woodie *et al.*'s movable plate (124) is part of the print head. This is not the case. The plate (124) is movable, so as to bring a ticket into contact with the print head (122), but the plate (124) is a part which is separate from the print head (122). Woodie *et al.* clearly discloses the print head as comprising only that part referenced by reference numeral 122.

In the technical field of this invention, the term "print head" has a clear and well-known meaning, namely, that part of a printer which contains the printing elements.

In the machine of Woodie *et al.*, the print head (122), which includes the printing elements, that is, the printing wheels, is fixed. Woodie *et al.* makes no disclosure or suggestion of the print head (122) being movable.

Inasmuch as Woodie *et al.* does not disclose a "mail opener" as recited in the preamble

of claim 18, and because Woodie et al. does not disclose a "print head" as commonly understood, or drive means operable to displace the cutting device, we submit that the invention of claim 18 is novel over the disclosure of Woodie *et al.*

Claims 19 - 21 and 26 - 27 depend from claim 18, and for that reason are deemed to be patentable as well.

Claim Rejections - 35 USC 103

Claim 22 is not obvious from Woodie et al. in view of Oussani (U.S. Patent 4419915), because Oussani does not cure the deficiencies of Woodie et al. discussed above.

While Oussani does show a rotary cutting blade, it does not do so in the context of a mail opener having a printing head. Moreover, it does not have means for displacing the cutter; rather, envelopes to be opened are moved across the blade. See Oussani, col. 4, lines 54 *et seq.*

Claims 23 - 25 are not obvious over Woodie *et al.* in view of Clark (U.S. Patent 4493252) because Clark does not cure the deficiencies of Woodie et al. noted above. Clark shows a postage meter having means for moving mail through it; however, it is not a mail opener, and thus does not have a cutting means or drive means for displacing the cutting means between operative and inoperative positions, as claim 18 requires.

We respectfully submit that the rejection of claims 18 - 27 ought to be reversed.



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## CLAIMS APPENDIX

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18. A mail opener for use with a postage meter including a print head movable between an operative, printing position and an inoperative position in which printing of mail pieces cannot be effected, the mail opener comprising:

a cutting device movable between an operative position to open mail pieces and a retracted, inoperative position in which the cutting device is maintained out of engagement with mail pieces; and

drive means operable to displace the cutting device between the operative and inoperative positions, the drive means being operated by movement of the print head into the printing position to move the cutting device into the inoperative position.

19. A mail opener as claimed in claim 18, wherein the postage meter includes a first mail piece feed guide, and the mail opener includes a second mail piece feed guide extending in alignment with the first mail piece feed guide, with the second mail piece feed guide being located to guide an edge of a mail piece into engagement with the cutting device when the cutting device is in the operative position and prevent engagement of mail pieces with the cutting device when the cutting device is in the inoperative position.

20. A mail opener as claimed in claim 18, further comprising:  
mechanical interlocking means operatively connected between the printing head and the cutting device.

21. A mail opener as claimed in claim 20, wherein the cutting device is carried by a movable member, and the interlocking means comprises a cam which engages the movable member, with operation of the cam causing movement of the cutting device between the operative and inoperative positions.



22. A mail opener as claimed in claim 18, wherein the cutting device is a rotatably-driven rotary blade.

23. A mail opener as claimed in claim 18, further comprising:  
driven feed means operative to draw mail pieces past the cutting device.

24. A mail opener as claimed in claim 23, wherein the driven feed means comprises a driven feed roller and a pressure roller co-operating therewith.

25. A mail opener as claimed in claim 23, further comprising:  
speed adjustment means for adjusting the speed of the driven feed means.

26. A mail opener as claimed in claim 18, wherein the drive means includes an electrical circuit responsive to movement of the print head to operate the drive means to locate the cutting device in the inoperative position in response to the print head being moved to the operative position.

27. A mail opener as claimed in claim 26, wherein the postage meter includes signal generation means operative to generate a signal in response to the print head moving to the operative position, and the electrical circuit of the drive means is responsive to the generated sign.

## EVIDENCE APPENDIX

[not applicable]

## RELATED PROCEEDINGS APPENDIX

[not applicable]